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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,385	11/26/2003	Lester F. Ludwig	A8682	6010

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WASHINGTON, DC 20037

EXAMINER
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DINH, DUNG C

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 02/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/721,385

Applicant(s)

LUDWIG ET AL.

Examiner

Dung Dinh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 8-12, 14, 16-35 and 39-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8-12, 14, 16-35, 39-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Response to Arguments***

Applicant's arguments filed 11/15/2005 have been fully considered.

The obviousness double patenting over patent 6,351,762 is withdrawn.

The argument is not persuasive with respect to the provisional obviousness double patenting. Applicant provided a summary comparing the amended claims on page 10 of the remark. As evidence by applicant summary of the claims, at least claim 1's of the '385/'905, '345 (10/721,343), and '051 applications are still substantially identical. The only different the '385/'905 and '051 is the phrase "no matter where the user is located". This feature is inherent from the use of the service record in claim 1 of the '385/'905 applications.

Regarding claim 1 of the '345 (10/721,343) application, the claim was amended to recite a quick dial list created from a list of all users. This language is not present in claims 1 of the '385/'905 and '051. However, the 'quick dial' list is equivalent to the 'personalized list' recited in the '385/'905 and '051 applications. Populating a personalized list using data from a master list clearly would have been obvious to one

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of ordinary skill in the art. Hence, claim 1 of '345 is not patentably distinct from claims 1 of '385/'905 and '051.

The provisional obviousness double patenting is maintained.

Regarding the rejection under 103, the argument is moot view of new ground of rejection below.

Claims 1-4, 8-12, 14, 16-35, 39-50 are pending for examination.

Copy non-patent references cited in this office action are provided in co-pending application 10/722,051.

#### ***Claim Rejections - Obviousness Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-50 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of Application No. 10/722,051, claims 1-37 of Application 10/721,343, claims 1-50 of Application 10/721,905. Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite substantially equivalent limitations or obvious variation thereof. This is a provisional rejection because the claims are not in fact patented.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.*

Claims 1-4, 8-12, 14, 16-35, 39-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michael Banks "America Online: A Graphics Based Success Evaluation", and further in view of Baumgartner et al. US patent 5,195,086, and Marshak "Beyond Mail for Windows" and Kamerman et al. US patent

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**5,519,834, Vin et al. "Multimedia Conferencing in the Etherphone Environment".**

As per claim 1, Banks teaches a communication system essentially as claimed, comprising:

a) at least one communication device for use by each user and having an associated display [user computer terminal];

b) at least one communication network to which the users log on [AOL network];

c) at least one service record for the first and second logged in users [apparent in order to indicate if a member is currently online. See page 3 first paragraph]; the service record including user identification (screen names) and associated location where the user is logged in no matter where they are located (page 3 1st paragraph see "where a member is from");

e) collaboration initiation software [AOL software] functions to cause retrieval of addressing information to cause the establishing of a connection between the participants thereby enabling real-time communication among the participants (apparent in order to establishing real-time conference and "instant-message" between users. See bottom of page 2 to top of page 3);

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wherein the system is configured to indicate to a user whether another user is not logged in (apparent from top of page 3 that a check to see whether a member is online would return a status of 'not logged in' if the member is not online).

Banks does not disclose video communication. Banks does not specifically disclose element d) computer software for displaying user identifiers with graphical icons for selection by the first user to establish a communication. In similar field of real time conferencing, Baumgartner teaches a conferencing system with directory displaying a list of available participants using icons for easy selection [see fig.18, col.15 lines 46-45, col.18 lines 57-60]. Baumgartner teaches providing video and text conferencing [col.14 lines 27-36]. AOL advantage of over other system at the time was the use of graphics (see page 1). Furthermore, Baumgartner discloses that graphical user interface is "an important idea for the conference room notion" (col.15 lines 42-45). Hence, it would have been obvious for one of ordinary skill in the art to combine the teaching of Baumgartner with AOL system to provide video conference and display of user name along with graphical icons because it would have enable face-to-face collaboration and improve the user interface by enabling the user to visually

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associate member with the icon and provided graphical means of selecting the participants for conferencing.

Baumgartner does not specifically disclose a selecting user identifier from a personalized list. Marshak discloses that it is known in the computer collaborative art to provide global and private directories to look up users of the system (address books - see page 4 "Managing address book"). It would have been obvious for one of ordinary skill in the art to provide a personalized list because it would have enable the user to more efficiently group and identify participants he wished to collaborate with instead of browsing through a long master list containing all users of the system.

As per claim 2, it is inherent that AOL system has service records including location information (e.g. data to effect routing such as address, port, modem bank, etc.) where the user logged in order to transmit data to the user terminal.

As per claim 3, Banks and Baumgartner do not specifically disclose a wireless device. Computer with wireless network access is well known in the art at the time of the invention (for example see Kameraman col.1). Wireless network connection reduces physical wiring and permits the computer to roam about. Hence, it would have been obvious for one of ordinary skill in the art to have a communication device being wireless device



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because it would have enabled the user to be mobile while participating in a conference.

As per claim 4, Baumgartner teaches the communication network is a wide area network (fig.14, 15).

Baumgartner discloses adding new user to an existing communication (col.17 lines 22+, merging and splitting calls).

As per claims 9-10, Baumgartner teaches the permitting a user to participating in multiple conferences at the same time (col.2 lines 6-15, col.18 lines 14-20). Baumgartner does not specifically disclose notifying of attempt to communicate by a third user. In similar field of computer conferencing, Vin teaches to automatic notifying user of attempt to communicate [page 77 col.2 ringing] and permit a user to participate in multiple conferences [page 78 col.3]. It have been obvious for one of ordinary skill in the art to provide notification to alert user of attempt to communicate with him so as alert the user to pending call while still participating in another conversation.

As per claim 11, Banks and Baumgartner teach allowing user to send email [Banks page 2 last paragraph 'e-mail' and Baumgartner col.14 lines 22].

As per claim 43, it is inherent that no service record exists for a user would indicate that the user is not online.

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As per claim 47, it is inherent that the AOL system includes some type of address information in order to route data the appropriate user terminal.

As per claims 25-34, 45 and 49 they are rejected under similar rationale as claims 1-11, 43 and 47 above. Baumgartner teaches the permitting a user to participating in multiple conferences at the same time (col.2 lines 6-15, col.18 lines 14-20). Baumgartner does not specifically disclose notifying of attempt to communicate to user. Official notice is taken that it is well known in the communication art to provide notification and identification of a caller (e.g. a phone ring and caller ID) so that the recipient can see who is calling and decide to take the call or not. Furthermore, in similar field of computer conferencing, Vin teaches to automatic notifying user of attempt to communicate [page 77 col.2 ringing] and permit a user to participate in multiple conferences [page 78 col.3]. It have been obvious for one of ordinary skill in the art to provide notification including identification of the caller because it would have enable the system to alert the user of incoming call and the identification would enable the user screen the call.

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As per claims 12, 14, 16-24, 44, 48 and 35, 39-42, 46, 50, they are rejected under similar rationale as claims 1-4, 8-11, 43 and 47 above. Banks and Baumgartner do not teach a communication device being wireless mobile phone. Computer with wireless access to network is well known in the art at the time of the invention (for example see Kameraman col.1). Wireless network connection reduces physical wiring and permits the computer to roam about. Hence, it would have been obvious for one of ordinary skill in the art to have a communication device being wireless mobile phone device because it would have enabled the user to dial-in to AOL while mobile.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dung Dinh whose telephone number is (571) 272-3943. The examiner can normally be reached on Monday-Friday from 7:00 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached at (571) 272-3949.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, consisting of a stylized 'D' followed by a horizontal line and a vertical stroke, with a long diagonal line extending upwards and to the right.

Dung Dinh  
Primary Examiner  
January 21, 2006